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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/762,552	01/23/2004	Dusan Hesoun	SYN-0037	3211

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EXAMINER

SOLOLA, TAOFIQ A

ART UNIT	PAPER NUMBER
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1626

DATE MAILED: 07/27/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

10/762,552

Applicant(s)

HESOUN ET AL.

Examiner

Taofiq A. Solola

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on 09 June 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☐ Claim(s) 1-33 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) 31-33 is/are allowed.
- 6) ☐ Claim(s) 1-15 and 30 is/are rejected.
- 7) ☐ Claim(s) 16-29 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

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Claims 1-33 are pending in this application.

***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.

Claims 1-15, 30 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 1-15 are not classifiable as required under 35 USC 8 and therefore indefinite. See MPEP 903. The claims do not have identifiable product. The phraseology "an intermediate-carbazolone reaction mixture" is not a sufficient identification of the product because several compounds having carbazolone ring are embraced by the phraseology. For example, formula (2) is not the product but is embraced by the phraseology. Under 35 USC 8, MPEP 903, all claims must be classified. The class and subclass(es) must be searched to determine patentability. It is mandatory under the US patent practice that every allowed claim be classified. MPEP 904. In a claim drawn to a process of making, the product determines the classification. In the instant invention, the product is not identifiable: structurally or by any other means.

Claim 30 is written in functional language and therefore, broader than the enabling disclosure. For example, the claim recites "converting" in line 1. The claim must recite how one of ordinary skill in the art would perform the "converting". The claims must recite the reagents, the reaction times, pH, and reaction conditions that are applicable in the step. Applicant may not claim all applicable processes of "converting" in the instant invention, known and yet to be

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developed. Applicant must claim only the "converting" process that embodies applicant's invention.

Applicant's arguments filed 6/9/05 have been fully considered but they are not persuasive. Applicant asserts that he is not required to define the product so as to fit USPTO classification system. While this assertion may be true, applicant should note that the Examiner needs not allow such claim because the Office must perform its duty in conformance with 35 USC 8 and other relevant statutes. Applicant also refers the Examiner to pages 7-8 of the specification for the identity of the product. This is not persuasive because such amounts to reading the specification into the claims contrary to many circuit courts' decisions. For example, applicant should read *Ex parte Fressola*, 27 USPQ 2d 1608, BdPatApp & Inter. (1993), which states that a claim must stand alone to define the inventions, and incorporation into the claims by reference to the specification or an external source is not permitted.

With reference to claim 30, Applicant argues that 35 USC 112, second paragraph does not have enablement requirement. This is not persuasive because the claim fails to recite any positive step as required under 35 USC 112, second paragraph. That is, the "how to". See the MPEP.

***Allowable Subject Matter***

Claims 16-29 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. Claims 31-33 are allowable over prior arts of record.

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

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A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

***Telephone Inquiry***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Taofiq A. Solola, PhD., JD, whose telephone number is (571) 272-0709.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mr. Joseph McKane, can be reached on (571) 272-0699. The fax phone number for this Group is (571) 273-8300.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (571) 272-1600.



TAOFIQ SOLOLA  
PRIMARY EXAMINER

Group 1626

July 25, 2005